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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/715,249 11/17/00 PIFPIG

S 4-31192/CIP

EXAMINER

HM12/0615

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ART UNIT

PAPER NUMBER

1636

DATE MAILED:

06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/715,249

Applicant(s)

PIPPIG ET AL.

Examiner

Lisa Gansheroff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: *detail action*.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 5-29, drawn to methods for identifying genetically modified mammalian cells, for immunoselection of transduced mammalian cells, and for identifying mammalian cells expressing a protein of interest, with respect to a nucleic acid encoding a modified EGFR family member, classified in class 435, subclass 6.
- II. Claims 1, 2, and 4-29, drawn to methods for identifying genetically modified mammalian cells, for immunoselection of transduced mammalian cells, and for identifying mammalian cells expressing a protein of interest, with respect to a nucleic acid encoding a modified MuSK-R family member, classified in class 436, subclass 6.
- III. Claim 30, drawn to a mutated MuSK-R family member, classified in class 530, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different methods and a product that is not used in the methods.

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Inventions I and II each comprise a step not present in or required for the other method. For example, the method of Invention I requires introducing into a cell a nucleic acid encoding a mutated/modified EGFR, while the method of Invention II requires introducing into a cell a nucleic acid encoding a mutated/modified MuSK-R. The product of Invention III, which is a receptor, is not used in the methods; the method of Invention I is not related to MuSK-R, and the method of Invention II required a nucleic acid encoding a MuSK-R receptor, but not the receptor, which is a protein and thus distinct from a nucleic acid.

Claims 1, 2, and 5-29 are generic to Groups I and II and will be examined only to the extent that they read on the elected Group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and because examination of the groups together would be a burden, restriction for examination purposes as indicated is proper.

A telephone call was made to Geoffrey Karny on 01 June 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa J. Gansheroff whose telephone number is (703) 605-1203. The examiner can normally be reached 9 AM - 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached at (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242 for regular communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Dianiece Jacobs whose telephone number is (703) 305-3388 or to the receptionist whose telephone number is (703) 308-0196.

LG
June 1, 2001



JAMES KETTER
PRIMARY EXAMINER